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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,286	06/22/2001	Ronald A. Katz	6646-101D7	9210

7590 10/18/2002

Attention: Reena Kuyper
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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,286

Applicant(s)

KATZ, RONALD A. *rd*

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 223-334 of copending Application No. 08/305,822. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the present claims and the copending claims is that the copending claims claim particular indicia printed on the substrate such as the telephone number being an 800-number. It would have been obvious to one having ordinary skill in the art to provide toll free number indicia on the substrate of the present claims, since the particular type of indicia applied to the substrate would only depend on the intended use of the assembly and the desired information to be displayed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24-26, 28-33, 35, 36, 38-41, 43 and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. ('530) in view of Roberts et al. ('553).

Barr et al. disclose the claimed invention including a product (10- ticket) for use with a telephone-interface system accessed through a telephone communication facility; the ticket being a base substrate having telephone number data (see figs. 1a, 1b, 2 and 3) which is to be entered by a caller via a telephone; the indicia (20) being unique identification data ("The number in the game area 20 may be different from the other number in other cards", see col. 2, lines 60-62; therefore, game area provides unique identification data); the substrate having additional data (30) printed thereon; obscuring means (22, 32) for obscuring the indicia; the obscuring means being provided over at least a portion of the unique identification data (as seen in figure 1).

Barr et al. disclose the claimed invention except for the indicia including a visual symbolic graphic representation and the additional data including a machine readable code.

Roberts et al. disclose lottery tickets having visual symbolic graphic representation (14) that is also represented in machine readable format (16). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Barr's invention to include graphic and machine readable indicia, as taught by Roberts et al., to provide indicia that is both aesthetically pleasing to the eye and provides tamper-proof capabilities for ensuring proper use of the lottery tickets.

As to the indicia on the substrate serving as a consumable key (claims 24 and 29) or telephone number data relating to called terminal digital data (claims 30 and 31) or the unique identification data being tested by a telephonic-interface control system to provide an indication of that limits (one time only use – claims 38 and 46; up to an extent of a limited dollar value – claims 40 and 48; during a defined interval of time – claims 45 and 47) specified on the use of the products that have been satisfied before allowing the callers to gain access to the at least certain operations of the specific telephone processing format (claims 32 and 41), the Examiner finds no new and unobvious functional relationship between the printed matter and the substrate upon which it is placed. That is, the relationship of the printed matter and the substrate merely set forth one of support and display. Accordingly, the content of the printed matter called

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for does not patentably distinguish over the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and *In re Miller*, 418 F. 2d 1392, 164 USPQ 46 (CCPA 1969).

4. Claims 27, 34, 37, 42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. in view of Roberts et al. and further in view of Goldman et al. ('708).

Barr et al., as modified by Roberts et al., disclose the claimed invention except for the substrate having a value assigned to the product.

Goldman et al. disclose lottery tickets having a value assigned (12 - \$1) to the ticket. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Barr's invention to include a value assigned thereto, as taught by Goldman et al., to visually provide the customer with an indication of price for the lottery tickets such that the customer would not have to rely on the seller to provide pricing information.

Response to Arguments

5. Applicant's arguments filed July 15, 2002 have been fully considered but they are not persuasive.

Applicant argues that Barr fails to disclose a cover over a unique identification number associated with the card. Further, applicant argues that Barr fails to disclose a

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unique identification number associated with the card. The Examiner disagrees. As disclosed by Barr, the game area 20 comprises a number that may be **different** from a number located on other cards (see col. 2, lines 60-62). Clearly, Barr is disclosing the game area to be a “unique” identification number that is associated with the card substrate. Further, Barr discloses an opaque covering 22 over the unique identification number. Therefore, Barr does fully disclose the claimed limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Barr discloses a lottery ticket for use with a telephonic-interface system. The ticket comprises unique identification number 20. Barr discloses that “For illustrative purposes, a telephone number 800-999-1000 is shown in FIG. 1a..... It will be understood that a group of letters or words could also be dialed into the telephone system and many choices of indicia are possible.” (see col. 2, lines 35-43). The number, therefore, is not restrictive to a telephone number. Roberts teaches lottery tickets having visual symbolic graphic representation (14) that is also represented in machine readable format (16). Therefore, it would have been obvious to provide the unique game data of Barr in machine

readable format for tamper-proofing of the ticket. Therefore, the Examiner maintains the combination of Barr and Roberts since they fully disclose the claimed invention.

Note: The Remarks with respect to the provisional rejection of claims 24-49 under the judicially created doctrine of obviousness-type double patenting are duly noted.

For the reasons as set forth above, the rejections are maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


mc

October 10, 2002


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700